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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/315,822	05/21/1999	SCOTT N. CHRISTENSEN	031792-0311520	6988

909 7590 07/21/2009
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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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07/21/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 Ex parte SCOTT N. CHRISTENSEN
11

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13 Appeal 2009-2957
14 Application 09/315,822
15 Technology Center 3600
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18 Oral Hearing Held: June 23, 2009
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21 Before MURRIEL E. CRAWFORD, ANTON W. FETTING
22 and JOSEPH A. FISCHETTI, Administrative Patent Judges
23

24
25 ON BEHALF OF THE APPELLANT:

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31 The above-entitled matter came on for hearing on Tuesday, June 23,
32 2009, commencing at 1:29 p.m., at the U.S. Patent and Trademark Office,
33 600 Dulany Street, Alexandria, Virginia, before Daniel Greenwald, Notary
34 Public.
35
36

1 JUDGE CRAWFORD: Okay.

2 MR. GATTO: Okay. A couple of kind of background points. With
3 respect to coupons, okay, certain things as we described in both the
4 specification and in the brief, I think they're worth just highlighting just to
5 make sure that they're -- in traditional couponing systems, a consumer will
6 print out a coupon, take it to a store, redeem it, and then usually the coupon
7 is sent to some coupon redemption center, and the coupon redemption center
8 will then -- on behalf of the coupon issuer, they will provide a credit back to
9 the store that gave the consumer some credit for redeeming the coupon.

10 Okay.

11 The -- it's kind of undisputed that in the prior art many of the --
12 what's referred to as a coupon redemption center is that redemption, right,
13 which is a redemption essentially by the store, occurs after the consumer has
14 redeemed the coupon at the checkout. Okay, and I'll come back to why
15 that's important in a second.

16 The other thing that's important is that in connection with determining
17 whether a product is eligible for a coupon, okay, there's Lemon and some of
18 the other references talk about making sure that you can't redeem a coupon
19 if you didn't buy the product, all right. That really, as we highlight, is
20 talking about the eligibility of a product for a coupon. What it doesn't
21 answer is the question that's really addressed by the specific claims in the
22 invention here is the coupon itself valid.

23 As disclosed in the background of the invention and even in some of
24 the prior art, coupon fraud is a huge problem, and it can occur in a number
25 of different ways. The invention addresses one aspect of coupon fraud.
26 Okay, the thing that it's trying to address is that in -- with electronic

1 coupons, for example, you can have a valid coupon and then make multiple
2 copies of it and redeem those copies. Those multiple copies would be
3 invalid coupons.

4 So to give you an example, if a manufacturer issues a coupon, says
5 you can buy a six-pack of beer, you get half off a six-pack of beer and gives
6 you a coupon and says you're entitled to one coupon and one six-pack of
7 beer. If I make three copies of that, the first time I redeem the coupon that
8 may be -- that's a valid coupon because that was the original. The three
9 copies and the subsequent three six-packs I buy, those are invalid coupons.
10 Even though the coupon relates to the product, it's the right product, the six-
11 pack of beer, all right, it still -- the coupon itself is invalid, because it's an
12 unauthorized copy.

13 JUDGE FETTING: Have you provided a definition to that regard in
14 the specification?

15 MR. GATTO: Yes. In connection, well, it functionally recites what
16 we're talking about there. So if you look, for example, at page 45, it refers,
17 for example, at line 20 that if a consumer attempts to redeem too many of a
18 particular coupon, authorization to redeem may be denied. That's one place
19 where it appears.

20 And in fact, if I can jump to -- I think if we look at some of the
21 dependent claims first, I think it's even -- it's abundantly clear with respect
22 to claims 4 and 13, for example. It's clear that claim 4 said that the
23 redemption includes counting the number of times a consumer redeemed a
24 particular coupon, and fraud indicating means for indicating fraud if the
25 number of times a coupon is redeemed exceeds a predetermined amount.

1 Now if you look at the Examiner's rejection of claim 4 with respect to
2 Barnett, what the Examiner says is that Barnett can limit the number of
3 times a consumer prints a coupon. Very different, right. You can print a
4 coupon once and still make copies, right. Barnett doesn't disclose doing the
5 real-time, you know, verification at the point of sale which is included in
6 claim 1, and claim 4 makes it more specific, what's specifically required
7 here.

8 And with respect to Lemon, the Examiner really doesn't address claim
9 4 specifically, and when we put this in our brief, if you look at the
10 Examiner's Answer, what the Examiner's Answer says with respect to the
11 dependent claims, including 4 and 13, is that well, these are just broad
12 claims, and they're generally disclosed by what I address in claim 1 or claim
13 11. I mean clearly the Examiner has not addressed the specifics of claims 4
14 and 13, and I think those claims absolutely the rejection is legally improper,
15 because it's just not even addressed with respect to the specifics that are
16 there.

17 In the Final Rejection, the Examiner did make an allegation that
18 Barnett discloses limiting the number of times you print a coupon but
19 doesn't talk about the specifics of claim 4. That just doesn't meet the claim
20 element. So I think with respect to those claims, it's clear that the rejection
21 is deficient.

22 Looking at the -- at claim 1 as an example, and the other dependent
23 claims have other limitations, but the last recitation of the redemption means
24 at the retail location including a scanner for scanning coupons at the retail
25 location checkout and means for determining if the coupon is valid prior to
26 crediting the consumer with the redemption value.

1 A couple of things there. There's specific structure there, including a
2 scanner. There's specific functions which includes scanning at the checkout
3 and a timing component of doing it before you give the consumer credit.
4 The Examiner in relying on Barnett we believe clearly misapplies Barnett.
5 In fact, what the Examiner says about Barnett is directly contrary to what
6 Barnett discloses. For example, the Examiner alleges that in Barnett that
7 Barnett is directed to a fraud-proof system. Well, the Examiner is actually
8 wrong. Barnett says it's virtually fraud proof. But in any event, what the
9 Examiner does by alleging that it's fraud proof saying well, you must in
10 Barnett do the scanning at the checkout. That's not what Barnett discloses.
11 Barnett clearly discloses at column 7 that the consumer -- I'll read the
12 exact -- at column 7, lines around 13, says the printed coupons are used in
13 the normal fashion by a consumer when shopping at a desired retail. So first
14 of all, the normal fashion is you present it, and it gets redeemed. There's
15 no -- there traditionally hasn't been, you know, checkout verification. Then
16 it says that as the coupons are presented to a product checkout station along
17 with the associated products, and the discount is credited to the consumer at
18 the point of sale. Then it says, and this is the important part, the redeemed
19 coupons, redeemed by the consumer, are transmitted to a coupon redemption
20 center where they are electronically read, and user's specific data is stored in
21 a coupon redemption database. The Examiner is relying on the reading of
22 the coupon at the redemption center after the consumer has been credited for
23 saying that Barnett discloses real time at the location, and that just simply is
24 inconsistent with what Barnett discloses.

25 JUDGE CRAWFORD: You know, your language in the claim is very
26 broad to me. You say they're determining if a coupon presented by the

1 consumer is valid, and the Examiner says when you make a determination
2 that, for instance, the date on the coupon is correct, that's a determination of
3 whether or not the coupon is valid. And also I think in the subsequent
4 rejections, determining whether or not that coupon is valid for that particular
5 product is also a determination about whether or not the coupon is valid.

6 MR. GATTO: That's --

7 JUDGE CRAWFORD: And I just can't, you know, I know you're
8 saying coupon itself, but that's not in the claim, and a coupon that's say
9 out -- I've taken coupons. They're out of date. They're not valid, and that's
10 a determination that appears to happen at the retail location using a scanner,
11 because Barnett does disclose a scanner, and to me I don't understand why
12 that doesn't meet the claim.

13 MR. GATTO: Because there's a couple things. There's both a
14 structure and a function, right. The -- even if you scan coupons, I think
15 some of the prior art talks about scanning to see if you bought the product,
16 right, for which the coupon applies. That doesn't tell you if the coupon is
17 valid, okay. That just says is that product eligible for a coupon. That's not
18 what -- we talk about product eligibility in the patent. That's separate from
19 validating the coupon. All right, we -- the problem in the background as we
20 highlighted in the Brief is that -- that we're trying to address here with these
21 claim recitations that is the coupon itself valid. Is it an authorized copy --

22 JUDGE CRAWFORD: I understand what you're, I understand what
23 you're trying to do and the difference. It's just I don't see how that's in the
24 claim.

25 MR. GATTO: Well --

1 JUDGE CRAWFORD: I think that a coupon that is for the wrong
2 soap powder is invalid for the product, so I don't understand how that is, and
3 plus a coupon that's out of date is not valid.

4 JUDGE FETTING: I think that part of the problem is that the word
5 valid and eligible are in many cases synonyms, and under a broadest
6 reasonable interpretation standard, the construction of one could encompass
7 the other. You're trying to distinguish the two, and unless you show us that
8 you have provided a very specific definition that would exclude eligibility
9 from within the scope of validity, then we have to say that they're essentially
10 synonyms.

11 MR. GATTO: Well, again, I think the fact that those terms are used
12 differently in the specification suggests that they're not synonyms. There's
13 a different -- saying a product is eligible and saying a coupon -- the claim
14 says determining if a coupon presented is valid. All right, it's not
15 determining whether it's product eligible. And again, because that's
16 separately used elsewhere in the specification, I think it's clear from the
17 context and the way this is being used in this case that's not what's meant by
18 valid.

19 But even if that broad interpretation were applied, it's very clear, for
20 example, in claim 4, right, that talks about where the redemption means
21 again --

22 JUDGE CRAWFORD: Yeah, I think you've got a different situation
23 with claim 4, so I take what you're saying about that one.

24 MR. GATTO: Okay, and claim 13. If we look at claim 11, this again
25 talks about a redemption module at the retail location. So even if you have a
26 scanner, right, there's nothing there that had the redemption module

1 determine if the coupon is valid prior to the consumer redeeming. Again, I
2 think they're similar arguments there and in claim 16 --

3 JUDGE CRAWFORD: Well, don't you think that determining
4 whether the coupon is the correct date has to do with the coupon itself and
5 whether or not it is valid?

6 MR. GATTO: It -- the -- in the context of the invention, no. That's
7 not what is meant by determining if the coupon is valid. I mean you could
8 have a valid coupon. I think the issue we're talking about is, for example,
9 unauthorized copying of the coupon. When you make the copy, it may very
10 well be that the date hasn't expired. It's still an invalid coupon, because it
11 was copied, and that's what the invention is focused on.

12 Some of the other things with respect to Lemon, for example, I mean I
13 think it's even clearer -- I'm focusing on Barnett but with Lemon, I mean
14 Lemon really just limits the number of times a coupon is printed, and that is
15 very different, because as I said earlier, you can limit the number of times a
16 consumer prints a coupon to one, and subsequent copies can be made. So
17 you know, we think Lemon clearly doesn't disclose the claim recitations that
18 we focused on.

19 In fact, back to the point about validating, the Examiner -- in the
20 Examiner's Answer at pages 24 and 25, you know, the Examiner seems to
21 acknowledge that although a user is able to print a particular coupon only
22 once, the issuer may be defrauded by someone who photocopies a printed
23 coupon numerous times. And I think the Examiner understands what the
24 claim is saying. He just -- when he goes to apply to prior art, it's just not
25 there.

1 JUDGE CRAWFORD: Well, I think he probably understands what
2 your invention is. But I don't know -- I'm just having a problem seeing that
3 reflected in the claim.

4 MR. GATTO: Okay. Okay, well, I understand your -- I mean we've
5 made the points why we think that the claim -- that that's what it means.
6 Clearly the dependent claims that we talked about I think are a separate issue
7 as you said. But it seems that the Examiner is kind of ignoring the express
8 teachings of Barnett, you know, as far as the redemption being done.
9 Regardless of how you interpret valid for a second, right, there is nothing in
10 Barnett that really talks -- no structure in Barnett that really is validating at
11 the point of sale. The Examiner says in the Answer, well, the checkout clerk
12 can check, you know, kind of look and see if the --

13 JUDGE CRAWFORD: Well, he says checkout clerk or the device. I
14 don't think he just says checkout clerk.

15 MR. GATTO: I believe the --

16 JUDGE CRAWFORD: What page is it on?

17 MR. GATTO: I think it's 26.

18 JUDGE CRAWFORD: Alone or in conjunction with a system.

19 MR. GATTO: But I -- the Examiner alleges that but there is
20 nothing -- I don't see anything the Examiner is alleging in Barnett that
21 discloses that anything in the system does any type of check like that at the
22 checkout. The only check that is done -- the only system check that's done
23 that I see in Barnett is at the redemption center.
24 And you know, it's kind of interesting for the Examiner to say that a clerk,
25 right, is you know, kind of, you know, reviewing a coupon to see if the
26 coupon date is valid, for example, if that even met the claim element. It's

1 kind of the analogous situation of all the 101 problems with Comiskey and
2 stuff. The Examiner is relying on mental steps, right, to meet a structural
3 recitation in the claim. There's means plus function. There has to be some
4 structure, you know, the structure disclosed or equivalent. There's no
5 structure, right, and we focused just on the Examiner alleging that the clerk
6 is doing it. There's no structure, and as far as the Examiner alleging that in
7 conjunction with the system, there's just no support provided by the
8 Examiner. There's no citation for where in Barnett there is anything in the
9 system that does this check at the checkout which is clearly claimed.
10 There's no dispute the claim says you're doing it, you know, scanning at the
11 retail location prior to giving credit. I mean all of that is very clear in the
12 claim. In Barnett, any system check is only at the redemption center after
13 credit has been given. So it's the wrong location, the wrong time.
14 So you know, even if there's a debate as to what it means to check validity at
15 the checkout, okay, Barnett doesn't disclose or the Examiner doesn't point
16 anything in Barnett that discloses a structure that actually performs that
17 function, and I don't think that you can rely on a clerk doing it manually to --
18 or mentally even to say that that meets the structural recitation of a means
19 plus function claim.

20 One other -- I mentioned two of the dependent claims. One of the
21 other dependent claims again that I think kind of ties into this point, just
22 briefly, is claim 12 for example, which further recites that the determining --
23 if determining the coupon is valid comprises accessing a database. So again,
24 that particular recitation would eliminate the ability for the Examiner to say
25 that a checkout clerk can do it mentally.

26 JUDGE CRAWFORD: Okay.

1 MR. GATTO: So I mean I think, I think that pretty much hits the
2 high point. I mean there's other arguments we made in the brief. I won't
3 reiterate all those, but I think those are the key issues, and yeah, I
4 understand, you know, I'd ask you just to consider that regardless of how
5 you may interpret the term "valid," right, or determining whether it's valid,
6 is there structure in Barnett? The Examiner doesn't cite it. Is there anything
7 at the checkout that does that, right, whether it's expiration date, etc. I don't
8 see any citation from the Examiner. So even if you could interpret that
9 broadly, we think the independent claims are still patentable over the prior
10 art, because that structure is missing. And even if you don't agree with that,
11 we believe that at least the dependent claims that require further structure
12 and specific functions at the checkout, those are just clearly not even
13 addressed by the Examiner. So we believe at a minimum those should be
14 clearly allowable.

15 Unless you have any further questions, I have no further comments.

16 JUDGE FETTING: Have any further questions?

17 JUDGE CRAWFORD: No. Thank you.

18 MR. GATTO: Thank you very much for your time.

19 (Whereupon, the hearing concluded on June 23, 2009.)